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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/872,522 | 06/04/2001 | Hideyuki Sakamoto | NEC01P072-TSe | 3317 |

30743 7590 07/22/2003

WHITHAM, CURTIS & CHRISTOFFERSON, P.C.
11491 SUNSET HILLS ROAD
SUITE 340
RESTON, VA 20190

EXAMINER

GARCIA, ERNESTO

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3679

DATE MAILED: 07/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/872,522

Applicant(s)

SAKAMOTO, HIDEYUKI

Examiner

Ernesto Garcia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 January 1959.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) 23-32 and 34-59 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 and 33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 June 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-8, 9-22 and 33, drawn to a method of trial purchase and a trial purchase system, classified in class 705, subclass 27.
- II. Claims 23-32, 49-54, 58 and 59, drawn to a backup means, classified in class 711, subclass 4.
- III. Claims 34-48 and 55, drawn to a method of gathering customer information on users of terminals and a customer information gathering system, classified in class 705, subclass 10.
- IV. Claims 56 and 57, drawn to a selling system, classified in class 709, subclass 203.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the different inventions are not disclosed as capable of use together and the backup means is a device for storing information versus a method of trial purchase.

Inventions I and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not used together. Invention I has the function of performing a trial purchase and invention II has the function of gathering customer information on users of terminals.

Inventions I and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the different inventions are not used together. Invention I is directed to a method of performing a trial purchase and invention IV is directed to a selling system which comprises an information-processing device such a server or storage and the system has a web management function.

Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not used together. Invention II has the function of gathering customer information and invention III is directed towards a storage device.

Inventions II and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not used together. Invention II has the function of storing information and invention III has the function of providing a commodity for trial purchase.

Inventions III and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not used together. Invention III is directed to a method of gathering customer information and invention IV is directed to a selling system for providing a commodity for trial purchase.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Michael E. Whitham on July 10, 2003 a provisional election was made without traverse to prosecute the invention of group I, claims 1-22 and 33. Applicant in replying to this Office action must make affirmation of

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this election. Claims 23-32 and 34-59 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Drawings

The drawings are objected to because Figure 1 has the word "campany" misspelled. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: "the commodity providing means includes means for previously storing the destination" (claims 10 and 11), "the commodity providing means includes means for storing the newly designated destination" (claim 12), and "the commodity providing means includes a means for providing the commodity for trial purchase at no charge" (claim 33).

Claim Objections

Claims 1-3 are objected to because of the following informalities:

regarding claim 1, the limitation "on a" in line 7 should be --of the--, "user" in line 11 should be --users--, and "terminal" in lines 9 and 11 should be --terminals--;

regarding claim 2, the limitation "previously stored" in line 6 should be deleted, and the limitation "terminal" in line 7 should be --terminals--.

regarding claim 3, the limitation "previously stored" in lines 5 and 8 should be deleted, the limitation "terminal" in line 6 and 7 should be plural. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 5 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Equinox's web page.

Regarding claim 1, the web page discloses a method of trial purchase, the method includes:

display information of a commodity (see serial hubs info) provided from a commodity providing means (the company, Equinox) on terminals (computers connected to the internet); and
users (the buyers), using the terminals, perform a purchase procedure.

Regarding claim 2, the method further includes:
previously store a destination of the commodity (the address is stored on the server before delivery of the product); and,
provide the commodity to the destination.

Regarding claims 5 and 6, the commodity (the serial hubs) is free of charge.

Claims 1-22 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Start Sampling.

Regarding claim 1, the startsampling.com's web page discloses a method of trial purchase, the method includes:

display information of a commodity (peanuts, tea, nasal strips, lifesavers are display on the first page) provided from a commodity providing means (the company or the site startsampling.com) on terminals (computers connected to the internet); and
users (the buyers), using the terminals, perform a purchase procedure.

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Regarding claim 2, the method further includes:

previously store a destination of the commodity (an address is stored on the server when the user enrolls to get products); and,
provide the commodity to the destination.

Regarding claim 3, the method further includes:

previously store a destination of the commodity (an address is stored on the server when the user enrolls to get products),

display the destination on the terminals when the commodity is specified on the terminals; and,

designate the destination or a newly designated destination as a destination of the commodity (users are allowed to change the address on the account).

Regarding claim 4, the method further includes:

storing the newly designated destination (a save button is usually associated with the account to update information).

Regarding claims 5-8, the commodity (samples are free of charge) is free of charge.

Regarding claims 9-22 and 33, given the method described by startsampling.com above, the trial purchase system is inherently constructed. A system includes a

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company (the commodity providing means), and terminals connected to the company via a web page using a network (the internet). The system further includes a database (the means for storing or previously storing a destination (the address)).

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Todd, Cunningham and Horstmann show a similar method of trial purchase .

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 703-308-8606. The examiner can normally be reached from 8:30-5:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne H Browne can be reached on 703-308-1159. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2168.


Lynne H. Browne
Supervisory Patent Examiner
Technology Center 3600

E.G.

July 15, 2003